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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/933,796      | 08/21/2001  | Tatia L. Battle      | TB-1                | 6716             |

7590 05/18/2007  
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| EXAMINER |
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GOTTSCHALK, MARTIN A

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| ART UNIT | PAPER NUMBER |
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3694

|           |               |
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| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

05/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/933,796

Applicant(s)

BATTLE ET AL.

Examiner

Martin A. Gottschalk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 30 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29, 31-45 and 47-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### **Notice to Applicant**

1. Claims 1-61 are pending. Claims 1-29, 31-45, and 47-61 have been examined. Claims 30 and 46 have been withdrawn.

### ***Election/Restrictions***

2. Applicant's election without traverse of claims 1-29, 31-45, and 47-61 in the reply filed on 12/21/2006 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-29, 31-45, and 47-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Hillegass et al (PG Pub#: US 2002/0007351, hereinafter, Hillegass).

(Note: For convenience, the Examiner has labeled the steps of claim 1 a-h.)

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A. As per claim 1, Hillegass discloses a method of providing tender from an issuer for a user transaction with a third party, comprising the steps of:

(a) receiving a request from the user for the tender in a specified amount ([0028]; user reads on "token giver." Note the various roles described as the "token distributor," "token receiver" (or "token user"); and "token giver." Note further that under certain circumstances, the token giver can also be the token receiver or user, [0029]);

(b) issuing to the user an item having a unique serial number to the user ([0030], reads on "token ID"; [0042]);

(c) retrievably storing item information associating the tender amount with the serial number ([0030], i.e. "...the token distributor stores...");

(d) receiving a request for funds from the third party, the request including the serial number and the amount requested (Fig 2; [0032]; note the "redemption process," where the third party is the receiver in the "gift certificate" scenario.

The Examiner notes that if the gift were cash, the redemption would be a request for funds from a third party. See also [0044] where in one scenario, funds are requested from the "Credit Card Processor" from the "License Provider." Note further in [0101], the request for credit card information to restore a license. Note further the funds being paid to the "Vendor" by the "License Provider" following

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purchase of a license. Note further in [0075], the interaction of the "License Authority" and the "Payment Authority.");

(e) accessing the stored item information to determine if the tender amount associated with the serial number is at least as large as the requested amount ([0032]);

(f) approving the request if the tender amount associated with the serial number is at least as large as the requested amount ([0032]);

(g) refusing the request if the tender amount associated with the serial number is less than the requested amount ([0033]);

and

(h) upon approval, retrievably storing additional item information associating the serial number with an indication that no further third party requests for finds can be approved ([0034]-[0035]; e.g. reads on "...date of the last transaction involving the token.").

B. Independent claims 29, 31, 45, 47, 54, 55, and 61 are rejected for the same reasons as claim 1.

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C. The remaining dependent claims, 2-28, 32-44, 48-53, and 56-60 are described throughout the Hillegass reference, so for instance paragraphs [0028]-[0033]; [0042]-[0044]; [0073]-[0091]; [0101]-[0104]; Figs 1-5, 6, and 11.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art describes systems of electronically-based alternative payment methods, using tokens, certificates, and other forms of funds transfer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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05/12/2007



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